

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

David CHINNER et al.

Serial No. 10/620,797

Group Art Unit: 2163

Confirmation No. 8455

Filed: July 17, 2003

Examiner: Patrick A. Darno

For: NETWORK FILESYSTEM ASYNCHRONOUS I/O SCHEDULING

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In the Examiner's Answer mailed April 30, 2008, the Examiner acknowledged that sections I - VI and the Claims Appendix were correct and on pages 3-7 repeated the rejection of the claims from the May 15, 2007 Office Action with some changes in formatting and slight rewording of introductory phrases.

"Examiner Notes"

In the last full paragraph on page 7 of the Examiner's Answer, there was a statement that "normally arguments are submitted under the heading 'Remarks' ..." Presumably the word "normally" in this sentence refers to responses to Office Actions, because 37 C.F.R. § 41.37 identifies the heading for Section VII of an Appeal Brief as "Argument" not "Remarks."

The remainder of the last full paragraph on page 7 of the Examiner's Answer noted that Section VII of an Appeal Brief "point[s] out disagreements with the examiner's contentions ... [and] discuss[es] the references applied against the claims, explaining how the claims avoid the references or distinguish from them." It is respectfully submitted that this is precisely what Section VII of the Appeal Brief filed January 15, 2008 provided.

The paragraph spanning pages 7 and 8 of the Examiner's Answer indicated that the Examiner had difficulty understanding how Section VII of the January 15, 2008 Appeal Brief "identif[ied] what the prior art did not disclose, did not describe, or did not suggest" apparently because the Examiner did not see phrases like "Nakaoka **did not teach or disclose** a user configurable metering" (emphasis in original) in the Appeal Brief. It is noted that 37 C.F.R. § 41.37 does not require the use of any specific phrases, but only requires that Section VII of an Appeal Brief present "contentions of appellant with respect to each ground of rejection presented for review ... and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on."

It is submitted that Section VII of the January 15, 2008 Appeal Brief met the requirements of 37 C.F.R. § 41.37. However, due to numerous unclear statements in the May 15, 2007 Office Action, Section VII of the January 15, 2008 Appeal Brief needed to explain how the May 15, 2007 Office Action was understood by the Appellants and as a result, may not have appeared to the Examiner to be as clearly focused on the issues of how the claims distinguished over the references as would "normally" be the case in an Appeal Brief. To aid the Board of Patent Appeals and interferences, as well as the Examiner who apparently is having difficulty understanding the arguments that have been presented by the Appellants, a summary of the arguments distinguishing the claims over the prior art will be provided at the end of this Reply Brief using the format suggested by the Examiner.

Following are responses to the issues addressed by the Examiner's Answer in the order in which they appear in the Examiner's Answer, even though the Examiner's Answer started with arguments on the last of three pages in the Appeal Brief discussing the independent claims.

Definitions of "Resource Acquisition Requests"

In response to the argument "that the 'tasks' in Nakaoka are not equivalent to 'resource acquisition requests' as that term is used in the subject application" (Appeal Brief, page 5, lines 8-9), the Examiner asserted that *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) supports the interpretation of "resource acquisition" as "the act of requiring a resource." It is irrelevant to the issues in this case whether this is a reasonable interpretation of "resource acquisition" because the term to be interpreted is "resource acquisition requests," not the adjective "resource acquisition." The Examiner's Answer failed to provide an interpretation of the term "resource acquisition requests" which the Appeal Brief argued was not equivalent to "tasks" in Nakaoka.

Further, the Examiner's Answer asserted "that the tasks of Nakaoka include 'the act of requiring a resource' for the task to be carried out" without citing anything in Nakaoka in support of this assertion. Therefore, even if a reasonable interpretation of "resource acquisition" is "the act of requiring a resource" and the word "request" can somehow be tacked on without providing any explanation of how the "tasks" in Nakaoka are equivalent to requests, the interpretation of "resource acquisition requests" in the Examiner's Answer is unsupported by the prior art and consists of mere assertion by the Examiner. For the above reasons, it is submitted that there has been no rebuttal of the arguments on page 5, lines 8-16 of the Appeal Brief.

Furthermore, the response to the arguments on page 5, lines 8-21 of the Appeal Brief, which appears on page 8 of the Examiner's Answer, at most addressed the term "resource acquisition requests" only with respect to claim 1. The subheading on line 7 of the Appeal Brief noted that there are "Variations in Definitions Provided by Claims 1, 11 and 21" and lines 16-21 on page 5 of the Appeal Brief discussed how claims 11 and 21 include additional language that may require a different definition, if the Examiner uses what Appellants would consider to be an **unreasonably** broad interpretation of the term "resource acquisition requests" in claim 1. The failure of the Examiner's Answer to address the additional language in claims 11 and 21 requiring a narrower definition of "resource acquisition requests" than that asserted in the Examiner Answer, means that the arguments at lines 16-21 on page 5 of the Appeal Brief were not rebutted by the Examiner's Answer.

Lack of Motivation to Combine

In response to the arguments in the last paragraph on page 5 of the Appeal Brief, the Examiner's Answer asserted that *KSR International Co. v. Teleflex Inc.*, 127 SCt 1727, 167 LE2d 705, 82 USPQ2d 1385 (2007) and *Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007) support an obviousness rejection based on the statement that "it would have been obvious ... to incorporate a user configurable metering disclosed by Nakaoka within the Clayton System for a faster execution, and efficiency for processing numerous amounts of request[s] that may be made by a user" (Examiner's Answer, page 10, lines 3-6). It is submitted that *KSR* and *Smith* did not go so far in their holdings as to permit examiner's to assert that it would be beneficial to combine references that the examiner found after reading the application unless reason(s) are provided why one of ordinary skill in the art would find it obvious to combine the teachings of two references without the benefit of hindsight.

The Board of Patent Appeals and Interferences in *Smith* phrased the issue as a "question ... [of] whether one of ordinary skill in the art starting with Wyant's two-ply pocket would have found it obvious at the time the invention was made to modify Wyant's pocket insert to include a continuous two-ply seam as taught by Dick for providing a more secure pocket." 83 USPQ2d at 1516. To answer this question, the Board considered the teachings of Wyant and Dick and determined that

(1) each of the claimed elements is found within the scope and content of the prior art; (2) one of ordinary skill in the art could have combined the elements as claimed by methods known at the time the invention was made; and (3) one of ordinary skill in the art would have recognized at the time the invention was made that the capabilities or functions of the combination were predictable.

83 USPQ2d at 1516-1517. Neither the May 15, 2007 Office Action, nor the Examiner's Answer contains any such analysis of the features taught by Nakaoka and Clayton et al., in particular, whether "one of ordinary skill in the art would have recognized at the time the invention was made that the capabilities or functions of the combination were predictable." Therefore, it is submitted that the reason given by the Examiner for combining Nakaoka and Clayton et al. does not meet the requirements of *KSR* and *Smith* for a finding that it would be obvious to combine the teachings of these two references.

Arguments Regarding Dependent Claims 2-10, 12-19 and 21-28

Pages 11-12 of the Examiner's Answer responded to the arguments regarding dependent claims 2-10, 12-19 and 21-28 that appeared on page 6 and the first paragraph on page 7 of the Appeal Brief. The paragraph at page 11, lines 9-16 of the Examiner's Answer repeated the attempted rebuttal of the lack of motivation to combine Nakaoka and Clayton et al. at the bottom of page 9 in the Examiner's Answer by citing *KSR* and *Smith*. The preceding two paragraphs confirm the lack of motivation to combine Nakaoka and Clayton et al., contrary to the statements at page 11, lines 9-16 of the Examiner's Answer.

The paragraph spanning pages 11 and 12 of the Examiner's Answer cited the specification of the application (even though the Examiner's Answer stated on page 8 that the claims are not to be interpreted in light of the specification) in paragraph [0006] as corresponding to column 10, lines 45-59 of Nakaoka, but failed to indicate what in this portion of Nakaoka disclosed sorting "the resource acquisition requests into at least two separate queues" as recited in claims 2, 12 and 21. No mention of "queues" or separating anything that might be equivalent to resource acquisition requests, such as "tasks" has been found in the paragraph spanning pages 11 and 12 of the Examiner's Answer, or in column 10, lines 45-59 of Nakaoka. All that is described in

this portion of Nakaoka is that "when the task object operation indicates the completion of the task, the field 7030 shows the task object which is to be completed" (Nakaoka, column 10, lines 57-59). In other words, this portion of Nakaoka teaches changing values of field 7030 when a task is completed, not "sorting" anything. Thus, it is submitted that the Examiner's Answer failed to rebut the arguments on page 6 and the first paragraph on page 7 of the Appeal Brief.

Arguments in the February 28, 2007 Amendment Unrebutted by the May 15, 2007 Office Action

On pages 13-14, the Examiner's Answer responded to arguments in the February 28, 2007 Amendment that were not addressed by the May 15, 2007 Office Action. The response to these arguments starts with an acknowledgement that the Examiner did not even perceive that the arguments had been made in the February 28, 2007 Amendment and perhaps was unable to recognize the arguments in the Appeal Brief.

Following the statement at page 13, lines 6-9 regarding the Examiner's failure to comprehend the arguments made in the February 28, 2007 Amendment, the Examiner's Answer repeated the interpretation of "resource acquisition" as "the act of requiring a resource" instead of providing an interpretation of "resource acquisition request" which is the term used in the claims, and noted that Fig. 8 of Nakaoka "illustrates types of task object operations" while Fig. 9 "illustrates task conditions ... expressed by a task". The Examiner's Answer then again discussed the specification of the application, instead of the claims, regarding sorting operations disclosed therein and cited column 10, lines 14-59 of Nakaoka, apparently as disclosing "sorting ... for different request types" (e.g., claim 2, lines 1-2). However, as discussed above, no suggestion of sorting anything has been found in column 10, lines 14-59 of Nakaoka. Apparently, the position of the Examiner is that the mere disclosure of "a code indicative of type of task object operation" makes it obvious to sort tasks by this code. However, nothing that has been cited, including Figs. 8 and 9 of Nakaoka has been found to teach or suggest a sorting operation. Therefore, it is submitted that the arguments made in the February 28, 2007 Amendment which were repeated at the end of the Appeal Brief continue to be unrebutted.

Summary of Arguments in Appeal Brief

As discussed at the beginning of the Reply Brief, following is a summary of the contentions made in the Appeal Brief regarding misstatements in the May 15, 2007 Office Action and the lack of teaching or suggestion in the prior art with respect to what is recited in the claims,

using the format suggested by the Examiner, with citation to where each contention can be found in the Appeal Brief.

(1) The May 15, 2007 Office Action acknowledged that Clayton et al. "does not disclose ... user configurable metering" (discussed at page 3, lines 11-18, of the Appeal Brief).

(2) The May 15, 2007 Office Action was inaccurate in stating that "defined in the applicant's remarks on page 7, the ... 'user configurable metering' would be the ability of a user to configure how the focus manager determines the number of request[s] of a given priority should be executed, Nakoma" (page 3, lines 15-17 of the May 15, 2007 Office Action, discussed at page 3, line 28 to page 4, line 10 of the Appeal Brief).

(3) Nakaoka did not teach or suggest "user configurable metering" (e.g., claim 1, lines 2-3) in a manner that can be combined with Clayton et al., i.e., Nakaoka fails to overcome the acknowledged lack of teaching or suggestion in Clayton et al. that a user can configure how the "focus manager 206" determines the number of requests of a given priority should be executed (as discussed at page 4, line 11 to page 5, line 6 of the Appeal Brief).

(4) Nakaoka did not teach or suggest anything equivalent to "resource acquisition requests" (e.g., claim 1, line 2), as discussed at page 5, lines 8-16 of the Appeal Brief, and certainly not "processing requests to access computing resources" (claim 11, line 2) or a "processor programmed to schedule execution of the resource acquisition requests" (claim 20, lines 3-4)), as discussed at page 5, lines 16-21 of the Appeal Brief and in the Reply Brief above.

(5) The reasons given for combining Nakaoka and Clayton et al. are inadequate, even under *KSR International Co. v. Teleflex Inc.*, as discussed at page 5, lines 23-32 of the Appeal Brief and in the Reply Brief above.

(5) Nakaoka does not teach or suggest sorting "the resource acquisition requests into at least two separate queues" as recited in claims 2, 12 and 21, as discussed at page 6, line 6 to page 8, line 5 of the Appeal Brief and in the Reply Brief above.

Conclusion

For the reasons set forth above and in the Appeal Brief, the February 28, 2007 Response and the July 11, 2006 Amendment, it is submitted that claims 1-28 patentably distinguish over Clayton et al. and Nakaoka. Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous.

Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

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Respectfully submitted,

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